UNITED STATES PATENT AND TRADEMARK OFFICE

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10/717,838	11/20/2003	Brian Stanley Locke	118156-00602	8559

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EXAMINER
WIENER, ERIC A

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 July 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,6,8-12,14,16,18-23,25,27 and 29-33* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,6,8-12,14,16,18-23,25,27 and 29-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible

for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR

1.114. Applicant's submission filed on 7/16/2010 has been entered.

2.   Claims 1, 2, 4, 6, 8-12, 14, 16, 18-23, 25, 27 and 29-33 are pending. Claims 1, 11, 21, and

22 are the independent claims. Claims 1, 11, 21, and 22 have been amended. Claims 3, 5, 7, 13,

15, 17, 24, 26, and 28 have been cancelled. Claims 1, 2, 4, 6, 8-12, 14, 16, 18-23, 25, 27 and 29-

33 have been rejected by the Examiner.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture,
> or composition of matter, or any new and useful improvement thereof, may obtain
> a patent therefor, subject to the conditions and requirements of this title.

4.   **Claims 1, 2, 4, 6, 8-10, 32, and 33 are rejected under 35 U.S.C. 101 because the**

claimed invention is directed to non-statutory subject matter.

Independent claim 1 is nonstatutory, because a "system" is claimed, wherein such a

"system" is not claimed to exist in a form that explicitly excludes possibly being interpreted as

existing solely as a system of software. The system of claim 1 claims that it comprises a

"graphical user interface" and "a task performance component." Both of these components of the

system of claim 1 may be interpreted to exist solely as software. Therefore, because software is

not statutory under 35 U.S.C. 101, claim 1 and its corresponding dependent claims are rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter.

It is recommended that the Applicant amend the system of claim 1 to explicitly tie the system to a non-transitory hardware element in order to render the claim statutory under 35 U.S.C. 101.

Specification

5.   The amendment filed 7/16/2010 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "random user-selectable" as amended into claims 1, 11, 21, and 22.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7.   **Claims 1, 11, 21, and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the presently amended language "random user-selectable" as amended into claims 1, 11, 21, and 22 does not comply with the written description requirement, because no mention of any type of random user-selectable order is made anywhere in the Specification. In fact, no mention of any type of random ordering of any sub-tasks is made anywhere in the Specification.

8.   **Claims 1, 11, 21, and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the presently amended language "random user-selectable" as amended into claims 1, 11, 21, and 22 does not comply with the enablement requirement, because a method of making a "user-selectable order" also be "random" was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   **Claims 1, 11, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Specifically, the presently amended language "random user-selectable" as amended into claims 1, 11, 21, and 22 is indefinite language, because it cannot be determined what is meant by the phrase "random user-selectable order." The use of the term "random" in describing an "order" contradicts the use of the term "user-selectable" in describing the same "order." It is unclear how an order can be *both* random and user-selectable at the same time, because a user-selectable order implies that the order cannot be random, because a user explicitly selects the order.

Therefore, claims 1, 11, 21, and 22 are rendered indefinite.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

12.   This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out
the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13.   Claims 1, 2, 4, 6, 8-12, 14, 16, 18-23, 25, 27 and 29-33 are rejected under 35 U.S.C.
103(a) as being unpatentable over Messinger et al. (US 7,000,187 B2) in view of Bach et al. (US
6,128,622) and further in view of Botscheck et al. (US 7,340,679 B2).

        As per independent claim 1, Messinger discloses *a system for assisting a user in
navigating through a performance of a task, the task including a plurality of sub-tasks*
(Abstract), *the system comprising:*

-   *a graphical user interface* (column 5, line 52 – column 6, line 12) *comprising:*

    o   *a list of two or more sub-tasks associated with the task* (column 6, lines 13 –
        30 and 58 – 65)*, the list including for each sub-task an identifier and a datum
        corresponding to a parameter* (column 10, lines 13 – 33); *and*

    o   *two or more panels, each panel associated with a respective sub-task in the
        list* (Fig. 13A)*;*

-   *a task performance component* (column 5, line 52 – column 6, line 12) *configured to:*

    o   *control a presentation of the two or more panels in the graphical user
        interface* (column 6, lines 53 – 57)*;*

    o   *for each of the two or more sub-tasks in the list, enable a user to perform the
        sub-task by entering information into the respective panel associated with the
        sub-task as the sub-task is presented* (column 10, lines 13 – 33)*;*

    o   *detect information entered by the user in a panel associated with a sub-task*
        (column 10, lines 13 – 33)*;*

> > o *determine a change in a datum corresponding to a parameter of the sub-task based on the information entered in the panels associated with the sub-task (column 10, lines 13 – 33);*
> >
> > o *dynamically determine a new sub-task that is required to be performed by a user to complete a task, the new sub-task being determined based on a change in datum corresponding to a parameter of the sub-task and automatically updating the list to include the new sub-task (column 3, lines 1 – 31).*

Messinger does not explicitly disclose that based on the information entered by the user in the panel associated with the sub-task, determine a change in a datum corresponding to a parameter of another sub-task, and automatically update the list to update the datum of the other sub-task.

However, in an analogous art, Bach discloses that *based on the information entered by a user in the panel associated with a sub- task, determine a change in a datum corresponding to a parameter of another sub-task, and automatically update the list to update the datum of the other sub-task* (column 9, lines 13 – 18 and column 10, lines 25 – 30).

In addition, it is of note that Back also discloses *dynamically determining a new sub-task that is required to be performed by a user to complete a task, the new sub-task being determined based on a change in datum corresponding to a parameter of the sub-task and automatically updating the list to include the new sub-task* (column 10, lines 25 – 30), wherein steps of a task guide sufficiently correspond to sub tasks, further wherein it has been interpreted that is components of a subsequent step are based on preceding steps, then these subsequent steps sufficiently serve as new dynamically determined steps. The subsequent steps are considered new, because up until the receipt of datum corresponding to parameters of a preceding step, the subsequent step cannot actually be defined, and thus upon the receipt of said datum, said subsequent step becomes a newly defined step that upon being defined is thus also automatically and dynamically included within the task guide.

Both Messinger and Bach pertain to the analogous art of wizard interfaces for performing tasks (Messinger, column 2, lines 4 – 18 and Bach, Abstract), and thus one would look to the other for possible improvements or variations to their respective inventions. In addition, Messinger discloses that a "step of displaying task indications includes a step of dynamically

changing the list of task indications as a function of the selectable graphical areas being displayed in the GUI window" (column 3, lines 21 – 24). Therefore, it would be obvious that Messinger would look to analogous such art as that of Bach to implement possible variations to the ability of dynamically changing the list of tasks, because Messinger also discloses that such analogous use of context-sensitive help is well known in the art of task-guidance applications such as wizards (column 1, lines 33 – 36), wherein the ability to dynamically contextually update the list would provide the obvious benefit of keeping the user current as to the determined results of use the wizard that have contextually related effects. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Messinger and Bach.

Messinger and Bach do not explicitly disclose enabling the user to perform the two or more sub-tasks in a random user-selectable order that is independent of a positional order in which the two or more sub-tasks are listed in the list.

However, in an analogous art, Botscheck discloses *enabling a user to perform two or more sub-tasks in a random user-selectable order that is independent of a positional order in which the two or more sub-tasks are listed in a list* (column 2, lines 31 – 43; column 3, lines 24 – 31; column 8, lines 48 – 59; and column 10, lines 49 – 63).

Messinger, Bach, and Botscheck all pertain to the analogous art of wizard interfaces for performing tasks (Messinger, column 2, lines 4 – 18; Bach, Abstract; Botscheck, column 1, lines 14 – 17), and thus one would look to the other for possible improvements or variations to their respective inventions. In addition Botscheck discloses that such needed improvements relate to information overload (Botscheck, column 1, lines 32 – 38) as well as to the possibility of a user being presented with a large variety of applications and information which may not be relevant to the particular task the user is performing (Botscheck, column 1, lines 50 – 55). Therefore, allowing users the possibility of performing tasks in an order-independent manner would overcome this difficulty by allowing a user to only perform the tasks needed, or to perform the tasks in a more desirable or relevant order, thus providing an obvious benefit to Messinger and Back. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Messinger, Bach, and Botscheck.

As per independent claim 11, the claim is substantially similar to the system of claim 1, except that it is directed to a *computer-implemented method* of executing the system of claim 1. However, Messinger discloses a computer-implemented method of executing the system of claim 1 (Abstract). Therefore, claim 11 is rejected on the same grounds as claim 1.

As per independent claim 21, the claim is substantially similar to the system of claim 1, except that the system includes a *means for displaying*, within at least one of the items, information corresponding to the sub-task represented by the at least one item. However, Messinger discloses a means for displaying, within at least one of the items, information corresponding to the sub-task represented by the at least one item (column 5, line 52 – column 6, line 12), where the means for displaying is the displayed GUI. Furthermore, a *means for operating, changing and updating* is provided through the computer controlling the system (Abstract). Therefore, the rest of claim 21 is rejected on the same grounds as claim 1.

As per independent claim 22, the claim is substantially similar to the system of claim 1, except that it is directed to a *computer-readable medium* for executing the methods of the system of claim 1. However, Messinger discloses a computer-readable medium for executing the methods of the system of claim 1 (Abstract). Therefore, claim 22 is rejected on the same grounds as claim 1.

As per claim 2, and taking into account the rejection of claim 1, Messinger further discloses that *the list is operable, for each of the two or more sub-tasks in the list, to control a display of the information entered by the user in the respective panel of the sub-task represented by the item* (column 10, lines 13 – 33), wherein it further would have been obvious to combine the teachings of Messinger, Bach, and Botscheck for the same reasons as disclosed in the rejection of claim 1, *supra*.

As per claim 4, and taking into account the rejection of claim 1, Messinger further discloses that *the list is operable to enable the user to perform the two or more of the sub-tasks in a temporal order in which the user selects the two or more sub-tasks from the list* (column 6, lines 13 – 24), wherein it further would have been obvious to combine the teachings of

Messinger, Bach, and Botscheck for the same reasons as disclosed in the rejection of claim 1, *supra*.

As per claim 6, and taking into account the rejection of claim 1, Bach further discloses that *the task performance component is operable to determine one or more of the sub-tasks required to perform the task based on information entered by the user in the respective panels of at least one of the two or more sub-tasks* (column 10, lines 25 – 30), wherein it further would have been obvious to combine the teachings of Messinger, Bach, and Botscheck for the same reasons as disclosed in the rejection of claim 1, *supra*.

As per claim 8, and taking into account the rejection of claim 1, Bach further discloses that *the task performance component is operable, in the event that information already has been entered by the user for a first sub-task, to determine that the first sub-task is no longer to be included in the list and to control notifying the user that confirming an acceptance of the information entered in the first panel will result in the information entered for the second sub-task being discarded* (column 9, lines 4 – 26), wherein it further would have been obvious to combine the teachings of Messinger, Bach, and Botscheck for the same reasons as disclosed in the rejection of claim 1, *supra*.

As per claim 9, and taking into account the rejection of claim 1, Messinger further discloses *performing the task of creating one or more rules of an access control sub-task list for a network device* (column 4, line 58 – column 5, line 6), wherein it further would have been obvious to combine the teachings of Messinger, Bach, and Botscheck for the same reasons as disclosed in the rejection of claim 1, *supra*.

As per claim 10, and taking into account the rejection of claim 1, Messinger further discloses that *the list is operable to vertically orient the list on the graphical user interface* (Fig. 13A), wherein it further would have been obvious to combine the teachings of Messinger, Bach, and Botscheck for the same reasons as disclosed in the rejection of claim 1, *supra*.

As per claim 12, and taking into account the rejection of the method of claim 11, the claim is rejected on the same grounds as claim 2.

As per claim 14, and taking into account the rejection of the method of claim 11, the claim is rejected on the same grounds as claim 4.

As per claim 16, and taking into account the rejection of the method of claim 11, the claim is rejected on the same grounds as claim 6.

As per claim 18, and taking into account the rejection of the method of claim 17, the claim is rejected on the same grounds as claim 8.

As per claim 19, and taking into account the rejection of the method of claim 11, the claim is rejected on the same grounds as claim 9.

As per claim 20, and taking into account the rejection of the method of claim 11, the claim is rejected on the same grounds as claim 10.

As per claim 23, and taking into account the rejection of the computer-readable medium of claim 22, the claim is rejected on the same grounds as claim 2.

As per claim 25, and taking into account the rejection of the computer-readable medium of claim 22, the claim is rejected on the same grounds as claim 4.

As per claim 27, and taking into account the rejection of the computer-readable medium of claim 22, the claim is rejected on the same grounds as claim 6.

As per claim 29, and taking into account the rejection of the computer-readable medium of claim 28, the claim is rejected on the same grounds as claim 8.

As per claim 30, and taking into account the rejection of the computer-readable medium of claim 22, the claim is rejected on the same grounds as claim 9.

As per claim 31, and taking into account the rejection of the computer-readable medium of claim 22, the claim is rejected on the same grounds as claim 10.

As per claim 32, and taking into account the rejection of claim 1, Botscheck further discloses that *the other sub-task is located higher than the sub-task in the positional order in which the two or more sub-tasks are listed in the list* (column 2, lines 31 – 43; column 3, lines 24 – 31; column 8, lines 48 – 59; and column 10, lines 49 – 63), wherein it further would have been obvious to combine the teachings of Messinger, Bach, and Botscheck for the same reasons as disclosed in the rejection of claim 1, *supra*.

As per claim 33, and taking into account the rejection of claim 1, Botscheck further discloses that *the other sub-task is located lower than the sub-task in the positional order in which the two or more sub-tasks are listed in the list* (column 2, lines 31 – 43; column 3, lines 24 – 31; column 8, lines 48 – 59; and column 10, lines 49 – 63), wherein it further would have been

obvious to combine the teachings of Messinger, Bach, and Botscheck for the same reasons as disclosed in the rejection of claim 1, *supra*.

Response to Arguments

14.   Applicant's Arguments filed on 7/16/2010 have been fully considered, but are moot in view of new grounds of rejection necessitated by amendment.

Conclusion

15.   It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)).

16.   *The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The cited documents represent the general state of the art.*

17.   Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric A. Wiener whose telephone number is 571-270-1401 and whose fax number is 571-270-2401. The Examiner can normally be reached during regular Office business hours, Monday through Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Weilun Lo, can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Eric Wiener/
Examiner, Art Unit 2179

/TuyetLien T Tran/
Examiner, Art Unit 2179